REMARKS

Note regarding claims

Pending independent claims 11, 24, and 29 have not been amended herein. Therefore, if any of these independent claims is rejected in the next office action on the basis of prior art not used in the most recent office action to reject the independent claim in question, then the next office action necessarily has to be non-final, and not final (see MPEP 706.07(a)).

Claim rejections under 35 USC 103

Claims 1, 3-11, 13-24, 26-30, and 32-34 have been rejected under 35 USC 103(a) as being unpatentable over Miyazaki (5,297,015) in view of Tustison (2004/0258141). Claims 2, 12, 25, and 31 have been rejected under 35 USC 103(a) as being unpatentable over Miyazaki in view of Tustison, and further in view of Potega (6,459,175). Claims 15-23 have been cancelled without prejudice.

Claims 1, 11, 24, and 29 are independent claims, from which the remaining pending claims ultimately depend. Applicant respectfully submits that the independent claims at least as originally presented are patentable over Miyazaki in view of Tustison. Therefore, the remaining dependent claims are patentable at least because they depend from patentable base independent claims. All the pending independent claims 1, 11, 24, and 29 are referred to herein as "the claimed invention."

The claimed invention recites a power supply that has a decoder circuit or that performs decoding functionality. That is, the decoder circuit is part of the power supply. For instance, in claim 1, the decoder circuit is recited as being part of the power supply. In claims 11 and 24, the decoder circuit is part of the power supply insofar as the power supply is recited as comprising the decoder circuit. In claim 29, the decoding functionality is explicitly recited as being performed by the power supply.

Miyazaki in view of Tustison does not suggest this aspect of the claimed invention. Rather, in Miyazaki in view of Tustison, the decoder circuit is not part of the power supply,

but rather is external to the power supply. Therefore, the power supply does not perform the decoding functionality, but rather the external decoder circuit performs the decoding functionality.

For example, the decoder circuit in Miyazaki in view of Tustison that performs the decoding functionality may be the modem 306 of FIG. 4 of Tustison. However, the modem 306 is external to the power supply 322 of FIG. 4, and is not part of the power supply 322. Therefore, the modem 306 performs the decoding functionality, not the power supply 322.

As another example, the decoder circuit in Miyazaki in view of Tustison that performs the decoding functionality may be the modem interface 350 of FIG. 4 of Tustison. However, the modem interface 350 is not part of the power supply 322; rather, the power supply 322 is part of the modem interface 350. The modem 306 is also part of the modem interface 350 of FIG. 4. Therefore, the modem 306 or the modem interface 350 can be considered as performing the decoding functionality, not the power supply 322.

Because the claimed invention recites a decoder circuit that is part of a power supply, such that the power supply performs the decoding functionality, and Miyazaki in view of Tustison does not disclose its decoder circuit as being part of a power supply, such that the power supply does not perform the decoding functionality, Miyazaki in view of Tustison does not suggest all the claimed invention as a whole. As such, Miyazaki in view of Tustison does not render the claimed invention *prima facie* obvious and unpatentable.

In this respect, Applicant notes that the MPEP states that "all the claim limitations must be taught or suggested by the prior art." (MPEP sec. 2143.03, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)) "All words in a claim must be considered in judging the patentability of that claim against the prior art." (Id., citing In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)) That is, "the claimed invention as a whole must be considered." (MPEP sec. 2141.02.I.) "Distilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" (MPEP sec 2141.02.II., citing W.L.

Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) At best, the Examiner has shown how the prior art renders obvious the "gist" or "thrust" of the invention, and not the claimed invention *as a whole*, considering *all* words and *all* claim limitations of the invention.

Including a decoder circuit within a power supply is advantageous. The patent application as filed notes that to adjust the amount of voltage and/or power provided by power supplies to electronic devices, the devices may include regulators (p. 1, ll. 17-19). However, including such regulators within the electronic devices is expensive, making their inclusion cost prohibitive for low profit margin devices (p. 1, ll. 22-26). Therefore, the claimed invention solves this problem, by permitting the electronic device to directly communicate with the power supply to indicate the level of voltage and/or power needed (p. 3, l. 29, through p. 4, l. 3). In this way, the amount of voltage and/or power provided by the power supplies to the electronic devices can be adjusted without having to employ expensive regulators.

By comparison, in Miyazaki in view of Tustison, the electronic device does not communicate with the power supply at all. For example, in Tustison, the data signals are sent over power lines, where the modem 306 of FIG. 4 intercepts the data signals, and the power supply 322 does not use these data signals at all. There is no way for the electronic device in Miyazaki in view of Tustison to communicate with the power supply 322. The only connection between the modem 306 and the power supply 322 in Miyazaki in view of Tustison is that the power supply 322 provides power to the modem 306 via connection 324 (see Tustison, para. [0029]). None of the data communicated by the electronic device is received by the power supply 322 in Miyazaki in view of Tustison, such that the power supply 322 cannot modify the power or voltage it generates responsive to any such data.

In this respect, then, Miyazaki in view of Tustison is directed towards a completely different type of problem than the claimed invention is. The point of providing communications over power lines in Miyazaki in view of Tustison is to "reduce the amount of wiring used" that

would ordinarily be used when there are separate communications or data lines, in order to "reduce weight and save space" within the electronic devices in question (see Tustison, para. [0010]). Miyazaki in view of Tustison is not concerned with the problem that the claimed invention solves, which is, namely, communicating the amount of power or voltage that a power supply should provide, directly to the power supply over the power lines (i.e., the interconnect). This is abundantly clear in light of the fact that Miyazaki in view of Tustison does not have its electronic device actually communicate with the power supply, as discussed above.

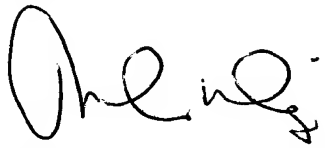
There is thus additional claim language of the independent claims that is not suggested by Miyazaki in view of Tustison. For instance, the power supply in claim 1 decodes signals received over the interconnect from the electronic device, such as into parameters on which basis the power supply converts AC power to DC power, as in claims 11, 24, and 29. Miyazaki in view of Tustison does not achieve this – the power supply of Miyazaki in view of Tustison never decodes signals received over the interconnect, let alone decodes such signals into parameters on which basis the power supply converts AC power to DC power.

Applicant hopes that the foregoing discussion distinguishes the claimed invention from Miyazaki in view of Tustison, and requests that the Examiner contact Applicant's representative, Mike Dryja, at the phone number listed below if this distinction has not been made clear. Applicant is potentially amenable to adding additional claim language into the independent claims, particularly claim 1, to patentably distinguish the claimed invention over Miyazaki in view of Tustison to the satisfaction of the Examiner, and thus requests that the Examiner contact Mike Dryja at the phone number listed below with any such proposals in order to get this patent application allowed as expeditiously as possible.[1] However, as it now stands, Applicant

[1] Applicant notes in this respect that it is the Examiner's obligation to engage Applicant to resolve patentability issues as expeditiously as possible, and that the Examiner shares with Applicant the responsibility of the success of the patentability process. As noted in a recent email from USPTO Director Kappos to the examining corps:

respectfully submits that the pending claims recite subject matter that is patentable over Miyazaki in view of Tustison.

Respectfully Submitted,



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> One key is to expeditiously identify and resolve issues of patentability—that is getting efficiently to the issues that matter to patentability in each case, and working with applicants to find the patentable subject matter and get it clearly expressed in claims that can be allowed. The examiner and the applicant share the responsibility for the success of this process.
> . . . . Let's be clear: patent quality does not equal rejection. In some cases this requires us to reject all the claims when no patentable subject matter has been presented. It is our duty to be candid with the applicant and protect the interests of the public. In other cases this means granting broad claims when they present allowable subject matter. In all cases it means engaging with the applicant to get to the real issues efficiently—what we all know as compact prosecution.

(Internet web site http://www.patentlyo.com/patent/2009/08/director-kappos-patent-quality-equals-granting-those-claims-the-applicant-is-entitled-to-under-our-laws.html) (Emphasis added)